

REMARKS

In response to the Notice of Non-Compliant Amendment, dated September 02, 2004, with the term for response having been extended 3 month(s), please consider the following remarks. Although the Applicants are only required to submit the corrected portion of the non-compliant portion of the Amendment, Applicants have also included the compliant portion of the Amendment in order to aid the Examiner.

The above referenced patent application has been reviewed in light of the Office Action, dated July 23, 2004, in which:

- the Applicants are required, under 35 U.S.C. § 121, to elect a single disclosed species for prosecution on the merits.

The PTO has asserted that the following are **distinct** species of the claimed invention:

- Species 1: claims 1-5;
- Species 2: claims 1, 6-9;
- Species 3: claims 10-15; and
- Species 4: claims 16-22.

The PTO further asserts that claim 1 is generic to species 1 & 2, whereas, species 3 & 4 have no generic claim.

Reconsideration of the above referenced patent application in view of the foregoing election and the following remarks is respectfully requested.

Claims 1-22 are now pending the above referenced patent application. No claims have been amended, cancelled or added. Claims 16-22 have been elected.

1. 37 C.F.R. § 1.121: Notice of Non-Compliant Amendment

The Amendment of August 23, 2004 was rejected under 37 C.F.R. § 1.121 because claims 16-22 were missing the notation “(Original),” due to an inadvertent error. Although the Applicants are only required to submit the corrected portion of the non-compliant portion of the Amendment, Applicants have also included the compliant portion of the Amendment in order to aid the Examiner.

2. Election Of One Species

Although the Applicants do not believe the restriction requirement is proper, nonetheless, Applicants elect to prosecute species 4, claims 16-22.

3. 35 U.S.C. § 121

Although the Applicants have elected to prosecute species 4, claims 16-22, Applicants respectfully traverse the restriction requirement and preserve the right to Petition the Commissioner.

M.P.E.P. § 803 sets forth both the standard of a *prima facie* case of § 121 restriction and the burden of proof for making the *prima facie* case.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

GUIDELINES

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases.

Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.

If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. In *re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02

It is respectfully asserted that the restriction is improper because the PTO has not “provide[d] reasons and/or examples to support conclusions,” and, therefore, not met the “serious burden on the examiner.”

It is respectfully asserted that the PTO has not attempted to show (1) any reasons for distinctness, (2) examples to support conclusions, (3) a separate classification of the species, (4) a separate status of the art, or (5) a different field of search. It is respectfully asserted that the PTO bears the burden of proof and has failed to make a *prima facie* case under § 121; therefore, the restriction is improper.

It is respectfully requested that the PTO either (1) provide examples and reasons for the assertion of distinctness as specified by M.P.E.P. § 806.05, or (2) withdraw the restriction.

Applicants respectfully reminds the PTO of the guideline of M.P.E.P. § 803 which states:

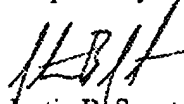
803 Restriction - When Proper

...
If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,



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Dated:

Wed Dec 15, 2004

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